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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/585,762	08/22/2007	Francesc Santanach	016906-0529	7826

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FOLEY AND LARDNER LLP  
SUITE 500  
3000 K STREET NW  
WASHINGTON, DC 20007

EXAMINER
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FERGUSON, MICHAEL P

ART UNIT	PAPER NUMBER
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3679

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/585,762	<b>Applicant(s)</b> SANTANACH ET AL.	
	<b>Examiner</b> MICHAEL P. FERGUSON	<b>Art Unit</b> 3679	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 24 June 2011.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 16-31 is/are pending in the application.
- 4a) Of the above claim(s) 20-23 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 16-19 and 24-31 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 July 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                       | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>02/28/11</u> .  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on May 11, 2011 has been entered.

### ***Election/Restrictions***

1. Applicant's election without traverse of Species 1, Figures 1 and 2, claims 16-19 and 24-28, in the reply filed on March 4, 2009 is acknowledged.
2. Claims 20-23 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on March 4, 2009.

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 16-19 and 24-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Diesel Kiki (JP 56-093316 U) in view of Orth (US 4,468,054) and Muller et al. (WO 03/081113).

As to claims 16-19, Diesel Kiki discloses a fixing device capable of use with a motor vehicle air-conditioning system including an evaporator, an expansion valve, and a plurality of lines **9,10,15,16**, comprising:

a housing **5a,5b** capable of housing at least the evaporator of the motor vehicle air-conditioning system in the housing, and

a positioning element **23** configured to position the lines relative to each other, wherein the positioning element has a first set of two through-holes configured to receive the lines, wherein the positioning element is a sheet-metal part,

wherein the positioning element is capable of being fitted and fixed with an expansion valve in at least a twist-proof manner on the housing (Figures 5-7).

Diesel Kiki fails to disclose a fixing device wherein the positioning element has a first set of two slots configured to receive the lines, wherein the positioning element is a sheet-metal punched part; wherein the slots configured to receive the lines are arranged parallel to each other in the positioning element.

Orth teaches a positioning element **78** having a first set of two slots **80,82** configured to receive lines **66**, wherein the positioning element is a sheet-metal part; wherein the slots configured to receive the lines are arranged parallel to each other in the positioning element; parallel slots **80,82** in sheet metal positioning element **78** enables one to quickly and easily assemble the positioning element over lines **66** with a simple translatory motion (Figure 1, column 3 lines 4-16). Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the fixing device disclosed by Diesel Kiki wherein the positioning element

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comprises a sheet-metal part having parallel slots as taught by Orth in order to enable one to quickly and easily assemble the positioning element over lines with a simple translatory motion.

Applicant is reminded that **process limitations are given little patentable weight in product claims** since the patentability determination of product-by-process claims is based on the product itself, even though such claims are limited and defined by the process. See MPEP § 2113. "The patentability of a product does not depend on its method of production. " In re Thorpe, 777 F.2d 695,698,USPQ 964,966 (Fed.Cir.1985). Accordingly, the process limitation of the positioning element being punched part in claim 1 is given little patentable weight. All that is required of such claim is that the positioning part is made of sheet metal and capable of being produced by a punching process.

Diesel Kiki fails to disclose a fixing device wherein the positioning element has a second set of slots and wherein the housing includes projections formed in a single piece with the housing arranged and shaped in accordance with the second slots of the positioning element such that the positioning element can be positioned on the housing in a rotationally secure manner to fix the positioning element on the housing, wherein the second set of slots extend in a line toward each other at longitudinal ends of the positioning element.

Muller et al. teach a fixing device wherein a fixing device wherein a positioning element **45** has a second set of slots **45.2** and wherein a housing **25** includes projections **25.1** formed in a single piece with the housing arranged and shaped in

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accordance with the second slots of the positioning element such that the positioning element can be positioned on the housing in a rotationally secure manner to fix the positioning element on the housing, wherein the second set of slots extend in a line toward each other at longitudinal ends of the positioning element; opposing slots **45.2** in positioning element **45** receive projections **25.1**, ensuring proper alignment of lines **10** within the positioning element and housing **25** and preventing relative rotation between the positioning element and the housing prior to fixedly fastening of the positioning element onto the housing (Figure 8; column 10 lines 19-52). Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the fixing device disclosed by Diesel Kiki wherein the positioning element comprises opposing slots receiving projections as taught by Muller et al. in order to ensure proper alignment of the lines within the positioning element and the housing and preventing relative rotation between the positioning element and the housing prior to fixedly fastening of the positioning element onto the housing.

As to claim 24, Diesel Kiki discloses a fixing device wherein the fixing device is capable of having an expansion valve fit on an outer side of the housing **5a,5b** with respect to an evaporator (Figure 6).

As to claim 25, Diesel Kiki discloses a fixing device wherein at least one hole **37** is provided in the positioning element **23** to pass a screw **24** through and the screw being capable of screwing into an expansion valve (Figure 6).

As to claim 26, Diesel Kiki discloses a fixing device wherein the housing **5a,5b** has a multi-part design, with a housing joint running in a direction transverse to a long axis of the positioning element **23** (Figure 6).

As to claim 27, Diesel Kiki discloses a fixing device wherein an opening **27a,27b** is provided in the housing joint, wherein the opening is configured to have at least one of the lines **15,16** protrude through the opening, with the at least one line capable of being connected to an expansion valve (Figure 6).

As to claim 28, the Diesel Kiki as modified by Muller et al. discloses a fixing device wherein the projection (**25.1**; Muller et al. Figure 8) extends from a surface of the housing (**5a,5b**; Diesel Kiki Figure 6) towards the positioning element **23**.

As to claim 29, Diesel Kiki as modified by Muller et al. discloses a fixing device wherein the second set of slots (**45.2**; Muller et al. Figure 8) are configured such that the second set of slots receives the projections (**25.1**; Muller et al. Figure 8) as the projections extend outwardly in a direction from the surface of the housing **5a,5b** towards the positioning element **23** (Diesel Kiki Figure 6).

As to claim 30, Diesel Kiki as modified by Muller et al. discloses a fixing device wherein the housing **5a,5b** comprises an opening **27a,27b** capable of receiving a plurality of lines **15,16** of an air-conditioning system through the opening, wherein the projections (**25.1**; Muller et al. Figure 8) of the housing are separate from and spaced apart from the opening (Diesel Kiki Figure 6).

As to claim 31, Diesel Kiki as modified by Muller et al. does not disclose any structural or functional significance and to the specific material of the housing and the projections.

The applicant is reminded that the selection of a known material based upon its suitability for the intended use, wherein there is no structural or functional significance disclosed as to the specific material of an element, is a design consideration within the skill of the art. In re Leshin, 227 F.2d 197, 125 USPQ 416 (CCPA 1960). Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the fixing device disclosed by Diesel Kiki as modified by Muller wherein the housing and the projections are formed by a single piece of injection molded plastic as Diesel Kiki as modified by Muller et al. does not disclose any structural or functional significance as to the specific material of the housing and the projections, and as such selection of material is a design consideration within the skill of the art which would yield expected and predictable results.

### ***Response to Arguments***

Applicant's arguments with respect to claims 16-19 and 24-31 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MICHAEL P. FERGUSON whose telephone number is (571)272-7081. The examiner can normally be reached on M-F (6:30am-3:00pm).



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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel P. Stodola can be reached on (571)272-7087. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MPF  
06/29/11

/Michael P. Ferguson/  
Primary Examiner, Art Unit 3679